

REMARKS

Applicants respectfully request entry of the above amendments, and consideration of the application, as amended.

By this amendment, the Applicants have amended the Specification to provide the filing date and serial number of the related application that were unknown at the time of filing. Applicants have also amended claims 1, 3, 7, 10, 13, 29, 30, 34, 37, 44, and 46; cancelled claims 2, 5, 6, 8, 11, 40, 42, 45, 47-49, 52, and 53; and introduced new claims 54-64. By these amendments, among other things, the limitations of original claim 11, which was objected to, were introduced to claim 1 and claim 11 and claims of related wording were cancelled. No new matter was introduced.

Claims 1, 3, 4, 7, 9, 10, 12-14, 23-25, 29-39, 44, 46, 50, 51, and 54-64 are now pending in this application.

1. Response to Objection of Claim 6

In paragraph 2 on page 2 of the Office Action, the Patent Office objected to the wording of claim 6. Claim 6 was cancelled, this objection is now moot.

2. Response to 112 Rejection of Claim 40

In paragraph 3 on page 2 of the Office Action, the Patent Office rejected claim 40 under 35 USC 112, second paragraph, as being indefinite. In the above amendment, Applicants cancelled claim 40.

3. Response to Anticipation Rejection based upon Burckhardt

In paragraphs 4 and 5 on pages 3 and 4 of the Office Action, the Patent Office rejected claims 1-5, 9, 10, 12-14, 44-46, 48-51, and 53 under 35 USC 102(b) as anticipated by what is disclosed in U.S. Patent 3,820,201 of Burckhardt [herein

"Burckhardt"]. However, Applicants respectfully submit that these rejections are inappropriate.

Applicants' undersigned Agent typically refers to the MPEP for guidance when considering whether an anticipation rejection is appropriate. For instance, MPEP § 2131 defines the conditions under which an anticipation rejection is appropriate:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim...

Applicants submit that Burckhardt does not include "each and every element" of the invention recited in these claims, nor does Burckhardt show the invention "in as complete detail" as these claims.

Applicants believe that it may be helpful to review the limitations of the invention recited in claim 1, specifically, the limitation "whereby the second aperture of the first ornament is laterally disposed from the first aperture of the first ornament." [Emphasis added.] According to aspects of the present invention, apertures are "laterally disposed" to each other when they are disposed in horizontal relationship when suspended, in contrast to a vertical relationship as is conventional. This orientation of the apertures is clearly illustrated throughout the application, for example, in Figures 6, 27, and 52. As described in paragraphs [00119] through [00125], this laterally disposed mounting provides at least four (4) advantages over conventional, prior art mountings, specifically:

1. The loading on each connector and each aperture is reduced;

2. The ornament loaded-thickness is increased;
3. A reduced tendency for connectors to disengage from an aperture; and
4. Undesirable pivoting of ornaments is minimized.

This mounting of the ornaments and the benefits this mounting provides are not provided by the cited art.

With respect to the rejection of claim 1 as anticipated by Burckhardt, Burckhardt is the very prior art over which the present invention is an improvement. Specifically, as illustrated throughout Burckhardt, the apertures in the ornaments of Burckhardt are not laterally disposed, as claimed, but vertically disposed. For example, Figures 1 and 2 of Burckhardt, in the vertically suspended ornament chain, the middle ornament 10 having two unnumbered apertures is oriented whereby the apertures are positioned in a vertical plane. These apertures are not "laterally disposed" as recited in claim 1. This ornament mounting arrangement does not provide the advantages of the present invention recited in paragraphs [00119] through [00125]. For this reason, Applicants respectfully submit that Burckhardt does not anticipate claim 1 and the Applicant requests that this rejection be reconsidered and withdrawn.

With respect to the rejections of dependent claims 2-5, 9, 10, 12-14, 44-46, 50, and 51, Applicants submit that these claims are not anticipated by Burckhardt for the same reasons that claim 1, from which they depend, is not anticipated. Applicants respectfully submit that these rejections be reconsidered and withdrawn.

With respect to the rejections of dependent claims 48, 49, and 53, Applicants respectfully submit that these claims are dependent upon allowed claim 42 and thus must also be allowable. The allowability of these claims is discussed further below in section 6.

4. Response to Anticipation Rejection based upon Schonbek

In paragraph 6 on page 6 of the Office Action, the Patent Office rejected claims 29-36 under 35 USC 102(b) as anticipated by what is disclosed in U.S. Patent 5,144,541 of Schonbek [herein "Schonbek"]. However, Applicants respectfully submit that these rejections are also inappropriate. Again, Applicants submit that Schonbek does not include "each and every element" of the invention recited in these claims, nor does Schonbek show the invention "in as complete detail" as these claims.

This aspect of the invention recited in claim 29 is most clearly illustrated in Figure 52 of the application, though Figures 43-51 also illustrate related features. Claim 29 has been amended to more clearly recite that the horizontal and vertical sections of the claimed channel do not comprise sides of the channels, as suggested by the Patent Office, but passages within the channel, as illustrated, for example, in Figure 43. Applicants submit that Schonbek does not disclose such passages. The features identified by the Patent Office are sides of openings 142, not passages as claimed.

Moreover, contrary to the statements made by the Patent Office, the openings 142 of Schonbek, which the Patent Office identifies as the claimed "channel," are not "adapted to receive the hook of the ornament and support the hook in the closed second end of the channel" as claimed. The Patent Office's comments suggest openings 142 receive a hook. However, examination of Figures 8, 10, and 11 of Schonbek clearly indicates that openings 142 receive octagonal crystal 144, not hooks. In fact, openings 142 are provided with a shape that is specially designed to receive an octagonal crystal, not a hook. As shown in Figures 9-11, the only aperture of Schonbek that receives a hook are the unnumbered circular apertures in ring 140. Thus, Applicants submit that Schonbek does not anticipate the inventions recited in claim 29 or its dependents. The Applicant requests that these rejections be reconsidered and withdrawn.

New dependent claims 60 and 61 further underscore the distinctions between Schonbek and this aspect of the invention by introducing the limitation that the plate be vertically oriented. The plate of Schonbek is clearly horizontally oriented, and would not provide its intended function if it were positioned vertically. In addition claim 61 recites that the edge of the vertically oriented plate where the open end of the channel is located be the bottom edge of the vertically oriented plate. Again, this feature clearly distinguishes from Schonbek.

5. Response to Anticipation Rejection based upon Bayer

In paragraph 7 on page 7 of the Office Action, the Patent Office rejected claims 37 and 38 under 35 USC 102(b) as anticipated by what is disclosed in U.S. Patent 5,109,325 of Bayer, et al. [herein "Bayer"]. However, Applicants respectfully submit that these rejections are also inappropriate. Again, Applicants submit that Bayer does not include "each and every element" of the invention recited in these claims, nor does Bayer show the invention "in as complete detail" as these claims.

This aspect of the invention recited in claim 37 is most clearly illustrated in Figure 52 of the application, though Figures 43-51 also illustrate related features. Claim 37 has been amended to more clearly recite that the horizontal and vertical sections of the claimed channel do not comprise edges of the channels, as indicated by the Patent Office, but passages within the channel, as illustrated, for example, in Figure 52. Applicants submit that Bayer does not disclose such passages. For this reason alone, Applicants submit that Bayer does not anticipate the inventions of claim 37 and its dependent claim 38.

Moreover, contrary to the statements made by the Patent Office, the slot 10 of openings 142, which the Patent Office identifies as the claimed "channel," is not "adapted to receive the hook of the ornament and support the ornament whereby the preferred direction of orientation of the ornament is directed substantially parallel to the planar surface of the plate" as claimed. The Patent Office's comments suggest that the

plane of "strip" 12 of Bayer is somehow parallel to the preferred direction of orientation of the ornament 6 of Bayer. However, as clearly shown in Figure 3F of Bayer, the plane of strip 12 is clearly vertical while the direction of orientation of ornament 6 is clearly horizontal, that is, in a direction to the right of the arrangement shown in Figure 3F. Again, Applicants submit that Bayer does not anticipate the inventions of claim 37 and its dependent claim 38. The Applicant requests that these rejections be reconsidered and withdrawn.

New claim 62 introduces a further limitation of the invention recited in claim 37 that is also not found in Bayer. Specifically, claim 62 recites that the channel further comprise an abrupt enlargement in width adapted to obstruct disengagement of the mounting hook from the channel. This abrupt enlargement is identified as feature 220 in Figure 44 and is described in paragraph [00109].

6. Allowable Subject Matter

In paragraph 8 on page 8 of the Office Action, the Patent Office identifies the subject matter recited in claims 6-8, 11, 39, 42, 47, and 52 as allowable if rewritten in independent form. However, the Applicant respectfully notes that claims 48 and 49 must also be allowable since claims 48 and 49 depend from allowable claim 47. Also, claim 53 must also be allowable since claim 53 depends from allowed claim 52.

In response to this identification of allowable subject matter, Applicants have redrafted claim 1 with the allowable limitations of claim 11 and redrafted allowable claim 42 as new independent claim 54. Applicants have also redrafted allowable claims 47, 48, and 49, as new dependent claims 55, 56, and 57. Claims 42, 47, 48, and 49 have been cancelled. Furthermore, allowable claims 52 and 53 have been redrafted as claims 58 and 59 dependent upon claim 54. Claims 52 and 53 have also been cancelled.

The Applicant acknowledges with appreciation the allowance of claims 23-25.

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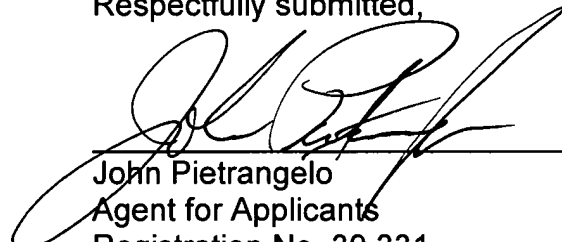
The Applicant recognizes with appreciation the acknowledgment of the allowability of this subject matter. However, as discussed above, Applicants believe that the Applicant is entitled to further protection in view of the prior art cited in the Office Action.

7. Conclusion

An early and favorable action on the merits of this application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned Agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



John Pietrangelo
Agent for Applicants
Registration No. 39,331

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HESLIN ROTHENBERG FARLEY & MESITI P.C.

5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579